

10D



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,620	01/24/2002	Kyu Yong Jung	05823.0199.01000	9253

7590 03/25/2004
 Finnegan, Henderson, Farabow,
 Garrett & Dunner, L.L.P.
 1300 I Street, N.W.
 Washington, DC 20005-3315

EXAMINER

COE, SUSAN D

ART UNIT PAPER NUMBER

1654

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/053,620	JUNG ET AL.	
	Examiner	Art Unit	
	Susan Coe	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 is/are allowed.
- 6) ☒ Claim(s) 3,4,6-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed December 23, 2003, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1 and 2 have been cancelled.
3. Claims 14-17 have been added.
4. Claims 3, 4 and 6-17 are pending.

Specification

The amendment filed December 23, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment adds numerous paragraphs discussing Oriental medicine and properties of individual ingredients. These paragraphs are not supported in the original specification; thus, they introduce new matter into the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Derwent English abstract of CN 1207942 A.

Applicant's claim is drawn to a composition comprising *Polygoni multiflori radix*. CN '942 teaches a composition that comprises *Polygoni multiflori radix*. CN '942 does not teach that the *P. multiflora* is the "Principal Drug;" however, the reference composition is still considered to anticipate applicant's claims because both the reference composition and the claimed composition are both compositions that comprise *P. multiflora*. Since the compositions are the same, any characteristics possessed by the composition would have to inherently be the same.

6. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,466,443.

US '443 teaches a composition that comprises *P. multiflora radix* (see abstract). The reference does not teach that the *P. multiflora* is the "Principal Drug" or has the same effect on the body as claimed; however, the reference composition is still considered to anticipate applicant's claims because both the reference composition and the claimed composition are both compositions that comprise *P. multiflora*. Since the compositions are the same, any characteristics possessed by the composition would have to inherently be the same.

7. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,916,555.

US '555 teaches a composition that comprises *P. multiflora radix* (see abstract). The reference does not teach that the *P. multiflora* is the "Principal Drug" or has the same effect on the body as claimed; however, the reference composition is still considered to anticipate

Art Unit: 1654

applicant's claims because both the reference composition and the claimed composition are both compositions that comprise *P. multiflora*. Since the compositions are the same, any characteristics possessed by the composition would have to inherently be the same.

Claim Rejections - 35 USC § 103

8. Claims 3, 4 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,010,702 in view of Japanese Pat. Appl. No. 07025777 A, Japanese Pat. Appl. No. 07179342 A, Derwent English abstract of Chinese Pat. Appl. No. 1207942 A, the Internet description of GERIFORTE tablets ((www.eisra.nl/gb/complex/geriforte.htm)) (1998)), US Pat. No. 5,707,631, and Japanese Pat. Appl. No. 06056684 A for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the references do not teach that *Polygoni multiflora* is the "Principal Drug" of the composition. In addition, applicant argues that a person of ordinary skill in the art would not be motivated to combine the compositions disclosed in US '702 and CN '942 because to arrive at the claimed composition would require substituting *P. multiflora* with the "Principal Drug," ginseng, of US '702. Applicant states that this substitution would not be made by a person of ordinary skill in the art of Oriental Medicine because ginseng has a "warm nature" while *P. multiflora* has a "cool nature." To further support this point, applicant argues that the "Principal Drug" of CN '942 is celery which has a "hot nature." Thus, it would not be obvious to use a "cool natured" drug such as *P. multiflora* as the "Principal Drug" in a composition to treat dementia.

These arguments are not found persuasive. Applicant's claims use the broad language "comprising" which allows for any additional ingredient in the composition including ginseng and celery. CN '942 and US '702 both disclose compositions that are useful in treating dementia. It has been well established legally and in the pharmaceutical field that it is considered obvious to combine two or more compositions together that are both known to be used for the same purpose. Thus, a person of ordinary skill in the art would reasonably expect that combining the entire composition of CN '942 with the composition of US '702 would result in a composition that functions to treat dementia even if some of the ingredients possess a "warm nature" or a "cool nature." Therefore, the combination of these references is still considered valid. The combination of the references as a whole leads to applicant's claimed composition. Since *P. multiflora* is present in the composition, it would function as the "Principal Drug" even if it is not explicitly disclosed as such.

Applicant also argues that the claimed composition has synergistic effects and has enjoyed commercial success. However, applicant has offered no evidence to support these assertions.

8. Claims 3, 4, 6-13 and 17 are rejected.

9. Claims 14-16 are allowable over the prior art because the prior art does not teach a composition that "consists essentially of" the claimed ingredients. The closest prior art, US Pat. No. 6,010,702, requires the presence of ginseng for its activity.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

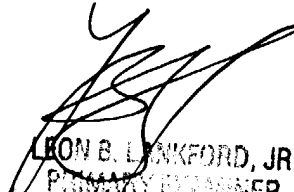
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner
March 19, 2004


LEON B. LINKFORD, JR.
PRIMARY EXAMINER